

Application No. 09/461,565
Amendment "H" dated June 28, 2005
Reply to Office Action mailed May 26, 2005

REMARKS

Initially, this response should be entered after final, without an RCE, because it does not provide any amendments comprising new limitations or raise any new issues that require new and additional searching. This amendment should also be entered after final because the statements made herein should be found to place the application in condition for immediate allowance.

The final Office Action, mailed May 26, 2005, considered and rejected claims 1-3, 5-6, 8-10, 20-21, 35-36, 38, 42, and 45-46 under 35 U.S.C. 103(a) as being unpatentable over Trovato et al. (U.S. Patent No. 6,425,012 B1) in view of Bussey et al. (U.S. Patent No. 6,785,708 B1).¹

By this paper, a couple of minor amendments have been made, changing the term "and" to the term "or." The context of the term being changed is within an "at least one of" statement, which provides different alternatives, and such that the change does not alter the intended scope of the claims, but merely clarifies the statement according to a preferred claiming format.

Inasmuch as the amendments do not introduce any new elements that need to be searched, this amendment is being submitted after final without an RCE. The amendment should also be entered inasmuch as the claims are already in condition for allowance over the art of record, for at least the reasons provided below, and as previously discussed with the Examiner.

Initially, Applicant reminds the Examiner that in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all claim limitations." MPEP § 2143.

However, in the present case, the cited art of Bussey and Trovato, even when combined, clearly fail to teach each and every claim limitation. To clarify how the cited art fails to teach each and every limitation, Applicants will focus on the independent claims (1, 20 and 46).

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last response, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

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In claim 1, the recited method includes receiving a video signal and chat communications which correspond to the video signal. As part of a first display mode, the video signal is displayed in a first frame and the chat is displayed in a second frame. Within the second frame, a link is displayed, to a second display mode. When this link to the second display mode is selected, the second frame displays the chat with at least one of a different size or position than was used in the first display mode and while still displaying video in the first frame.

A link to a third display mode is also displayed within the second frame when the second frame is displayed in the second display mode. When this link is selected, then the second frame displays the chat with at least one of a different frame size or position than was used by the second frame in the first and second display modes.

Now, in rejecting the claims, the Examiner has relied on Trovato and Busey. Trovato discloses a system that enables a television broadcast and chat to be displayed simultaneously. In particular, with specific regard to the disclosure cited by the Examiner, Trovato teaches that a "chat room may appear as a picture-in-picture image on the television 252, or the television broadcast may appear as a picture-in-picture image in a display of the chat room." Col. 6, ll. 56-59. However, this disclosure clearly falls short of teaching or suggesting the display of different frames for video and chat, respectively, wherein a link is displayed in the chat frame for switching to a second display mode in which yet another link is displayed in the chat frame for switching to a third display mode that is different than both the first and second display modes, as claimed.

The Examiner acknowledges that Trovato does not teach the use of the first and second links to switch display modes. To compensate for the failures of Trovato in this regard, the Examiner asserts that "Busey clearly teaches there are more than one links in the chat section linking to different chat mode or other users."

Applicants respectfully point out, however, that even assuming, *arguendo*, that the Examiner is correct about Busey teaching a plurality of links to different chat modes or other users, the combination of Busey and Trovato still fails to establish a *prima facie* case of obviousness because the purported teachings still fail to teach each and every claim limitation. In particular, it should be appreciated that a purported 'teaching regarding a plurality of links to different chat modes or users' is not the same as the claim limitation requiring the display of different frames for video and chat, respectively, wherein a first link is displayed in the chat

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frame for switching to a second display mode (wherein the chat frame is displayed **with at least one of a different size or position than was used in the first display mode**) and in which yet another link is displayed in the chat frame for switching to a third display mode that is different than both the first and second display modes (wherein the chat frame is displayed **with at least one of a different size or position than was used in the first or second display modes**), as claimed.

While the Examiner suggests that Busey discloses different links, the Examiner has not even purported that Busey's links cause a chat frame to be displayed with at least one of a different size or position. Perhaps, this is because Busey doesn't teach or suggest this. Instead, Busey's "Fixit" hyperlink referred to by the Examiner merely redirects the user to a new website featuring content corresponding to the Fixit hyperlink. Col. 7, ll. 38-40. In fact, contrary to applicants recited claims, selection of the Fixit hyperlink in Figure 4B actually appears to drop the chat frame altogether, such that only the new and corresponding Fixit webpage is displayed, as shown in Figure 4C. The user can then launch a new chat session by clicking on one of the links in the webpage.

Accordingly, not only does Busey fail to disclose that selection of a link in a first mode causes the chat or second frame to display the chat with at least one of a different size or position, it fails to display the chat at all when the Fixit hyperlink is selected. (Figs. 4B-4C and Col. 7, ll. 38-40).

The Examiner also states that Trovato teaches that "the chat section or television section can be resized or change position (minimized, maximized or altered in size to one and another). (e.g., col. 6, lines 55-60)." However, the cited disclosure in col. 6, ll. 55-60 only mentions picture-in-picture functionality, as quoted above. It does NOT make any mention or suggestion that the chat section "can be resized or change position (minimized, maximized or altered in size to one and another)," as purported by the Examiner. Accordingly, it appears that the Examiner is relying on unstated official notice or an unstated assertion that such resizing or changing of position would be within the ordinary skill of one in the art. However, this is inappropriate for at least the following reasons.

The "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS." MPEP § 2143.01. This is true even when "the references relied upon teach that

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all aspects of the claimed invention," which in the present case they clearly don't. *Id.* In particular, Trovato clearly fails, among other things, to disclose the recited changing of at least one of a size or position of a frame in response to a selection of a link that is displayed in the chat frame.

Nevertheless, even if Trovato in combination with Bussey did teach resizing or repositioning of a chat frame based on a selection of a displayed link, "A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made"" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." *Id.* In the present case, not only are all of the elements not taught by the combined art, there is no such objective reason provided to combine the references.

The Examiner does state that it would be obvious to combine Bussey and Trovato "to have the multiple chat sections of Bussey in the PIP of TV and chat of Trovato in order to chat with more users during the particular event." However, this statement does not represent an objective reason or motivation for combining the references to reject the pending claims. Initially, chatting with multiple users does not appear to provide any nexus with changing at least one of the size and position of the chat frame in response to the selection of a link, as claimed, such that the purported teachings being combined fail to correspond to the recited claim elements.

Furthermore, even if all of the recited claim elements were taught by the combined cited art, which they aren't (as clarified above), Applicants remind the examiner that the purported motivation to combine the references must come from the references themselves, not the Applicant's own application², otherwise such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure." *Id.* (emphasis added).

In this regard, there is nothing in the art that would motivate one of ordinary skill in the art to provide a first link in a chat frame that, when selected, causes the chat frame to be

² MPEP 2143, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

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displayed with at least one of a different size or position and with a new link to a third display mode, and such that when the new link is selected that the chat frame is displayed in a third display mode having at least one of a different size or position that was used in **both the first and second display modes**, as claimed. In fact, it has not even been asserted by the examiner that the chat frame displayed in the second display mode is displayed with a new link to the third display mode that is different than both the first and second display modes, as claimed in claims 1 and 20, for example.

Although the foregoing discussion has primarily focused on switching from a first display mode to a second display mode in response to a selection of a first link, it will be appreciated that the same arguments also generally apply to the recited use of a second link for switching from the second display mode to the third display mode.

Accordingly, for at least the foregoing reasons, Applicants respectfully point out that a *prima facie* case of obviousness has not been established for rejecting claim 1. Claim 20, which recites the same basic limitations, only in functional "means for" language is also distinguished from the art of record for at least the same reasons.

Finally, claim 46 is also distinguished from the art of record for similar reasons. In particular, claim 46 recites a similar method as recited in claim 1, but without requiring the second link to be displayed, and wherein selection of the first link causes **both** of the first and second display frames to be displayed with at least one of a different size or position.

In this regard, both *Trovato* and *Bussey* clearly fail to teach that **both** the first and second frames change at least one of their size or position in response to the selection of the displayed link in the chat frame. Accordingly, claim 46 should also be found allowable over the art of record inasmuch as each and every claim limitation in claim 46 is not taught or suggested by the art of record.

At this late stage in prosecution, following several in person interviews and several amendments, Applicants respectfully submit that the art has been thoroughly searched and the scope of the invention should be very clear. In view of this and the foregoing remarks, it should also be clear that the claims are clearly distinguished over the art of record. Accordingly, unless some newly allowed art, which was previously unpublished is discovered, which is found to read on the claims, Applicant respectfully submits that the claims should be allowed.

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Although the forgoing remarks have focused primarily on the independent claims, it will be appreciated that, for at least the foregoing reasons, all of the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should the need arise, including the rejections to any of the dependent claims and any official notice.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 28 day of June, 2005.

Respectfully submitted,



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